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MAY 14 2004

OFFICE OF THE DIRECTOR
TC 3600

In re Application of
Gary Johnson
Serial No: 10/021,656
Filed: December 12, 2001
For: JOHNSON-POSITIVE ACTION CONTINUOUS
TRACTION (P.A.C.T.) VEHICLE DIFFERENTIAL

: DECISION ON PETITION
: UNDER 37 CFR 1.181
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:
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This is a decision on the Petitions under 37 CFR 1.181 filed April 1 and 5, 2004 for Supervisory Review of the final rejection mailed October 16, 2003.

The petition is **GRANTED** to the extent indicated below.

A review of the application file history reveals that a first Office action was mailed January 10, 2003 in which the examiner rejected claims 1-3 under 35 U.S.C. 112 and 35 U.S.C. 102. An amendment was received on February 25, 2003 in response to the Office action mailed January 10, 2003, which canceled claims 1-3 and added claims 4-6. Another Office action was mailed May 5, 2003 objecting to the drawings and rejecting claims 4-6 under 35 U.S.C. 112. A handwritten amendment was received July 31, 2003 in response to the May 5, 2003 Office action, which amended the drawings, added a new section to the specification, canceled claims 4-6 and added claims 7-8. A final rejection was mailed October 16, 2003 that: refused entry of the amended drawing based on new matter; refused entry of the changes to the specification as not complying with 37 CFR 1.125 because a statement was not included that the new specification did not include new matter and a marked up copy of the new specification was not included; refused entry of the amendment to the claims canceling claims 4-6 and adding claims 7-8 because the handwritten text was not double spaced and was hard to read; and again rejecting claims 4-6 under 35 U.S.C. 112. A Notice of Appeal was filed December 11, 2003 and an improper Appeal Brief was filed December 30, 2003. An amendment was received March 16, 2004 amending the drawings, adding a new section to the specification, providing a statement that the new section of the specification does not include new matter, canceling claims 4-6 and adding claims 7-8. An amendment was received April 12, 2004 which appears to be a duplicate of the March 16, 2004 amendment.

With regard to the October 16, 2003 final rejection, the examiner acted properly in refusing entry of the amendments to the drawings until the question of new matter is settled. See MPEP 714.19. The examiner erred in refusing to enter the added section (paragraphs) to the specification. The section applicant wishes added is not a substitute specification. Therefore the amendment to the specification does not fall under 37 CFR 1.125 and does not require a marked

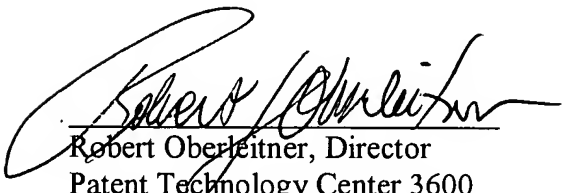
up copy. It should fall under 37 CFR 1.121(b)(1). The examiner also erred in his handling of the July 31, 2003 amendment to the claims by refusing entry of the amendment to the claims, acting on the previously presented claims 4-6 and making his action final. Again, the amendment to the claims must also comply with 37 CFR 1.121(c). See MPEP 714.

The amendments to the specification and claims filed July 31, 2003 should have been refused entry on the basis of their being non-compliant with 37 CFR 1.121. No instruction was provided which unambiguously identifies the location to add the new section. Also, the request to delete the sentence from the "Detailed Description of the Drawing" is improper and should be done by deletion and replacement of the paragraph. See 37 CFR 1.121(b)(1). An amendment to the claims must include a complete listing of all claims in the application and the status of each claim indicated in a parenthetical expression after each claim number. See MPEP 714, III, 3. A Notice of Non-Compliant Amendment should have been sent to applicant setting a time limit of one month for reply during which time applicant would have the opportunity to correct the problems with his amendment under 37 CFR 1.121.

By the examiner not having a Notice of Non-compliant Amendment sent to applicant and directing the final Office action to claims 4-6, the final rejection mailed October 16, 2003 was improper. Therefore the October 16, 2003 final rejection is hereby vacated. Since the final rejection was improper, applicant should not have been forced to file a Notice of Appeal and its required fee. Therefore, the fee for the Notice of Appeal will be refunded to applicant.

This file will be forwarded to the Supervisory Legal Instruments Examiner to vacate the final rejection of October 16, 2003, refund the fee for the Notice of Appeal and provide applicant with a Notice of Non-compliant Amendment for the amendments applicant has filed July 31, 2003, March 18, 2004.

SUMMARY: The petition is **GRANTED** to the extent indicated.



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